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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 075834.00460	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>2/6/08</u> Signature <u>[Signature]</u> Typed or printed name <u>Robert J. Depke</u>		Application Number 10/733,058	Filed December 11, 2003
		First Named Inventor Hikaru Kobayashi et al.	
		Art Unit 2854	Examiner Matthew G. Marini
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 37,607 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

Signature  
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Telephone number  
2/6/08  
Date

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/733,058  
Applicant: Hikaru Kobayashi  
Filed: December 11, 2003  
TC/A.U.: 2854  
Examiner: Matthew G. Marini  
Docket No.: 075834.00460  
Customer No.: 33448

Confirmation No.: 7840

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW ACCOMPANYING  
NOTICE OF APPEAL**

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Alexandria, Virginia 22313-1450

S I R:

**ERRORS IN THE PRIOR REJECTION**

Consistent with the Review Requirements for identification of clear errors, Applicants note the following:

- I. The prior art reference of *Jenkins* (USPN 4,457,981) fails to anticipate each and every limitation of any one of claims 6 – 13, and the Examiner's rejection is clearly erroneous and should be reversed by the Panel.
- II. The prior art references of *Jenkins* (USPN 4,457,981) and *Campbell* (USPN 4,747,782) fail to disclose, teach, or suggest the subject matter contained in claims 14 – 16, and the Examiner's rejection is clearly erroneous and should be reversed by the Panel.

**REMARKS**

**A. The §102 Rejection of Claims 6 - 13 Is Clearly Erroneous**

Applicants respectfully request review of the Examiner's rejection of claims 6 – 13 under 35 U.S.C. §102(b). The Examiner has rejected these claims in view of the cited prior art reference of *Jenkins* (USPN 4,457,981). The *Jenkins* reference is directed to an improved

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method of making composite web rolls, and to a labeling method, such that substantially a same amount of adhesive is provided on a wide label as on a narrow label. (Col. 1, lns 54 – 65). The Examiner cites Fig. 3 as disclosing Applicant's currently claimed invention. The Examiner stated in the last Office Action that *Jenkins* discloses "wherein neither the first portion, where cuts, 44, occur, nor the second portion, where images, 38 are printed contain width-wise cuts in a direction perpendicular to the conveying direction of the printing medium, 30 and 35." Furthermore, the Examiner stated in the Response to Arguments section that "...cuts made by roller, 39, do not penetrate the print layer, Col. 3 lines 54 – 58, but only the bottom layer, 30."

First, Applicants note that at no point does Applicant's claim 6 distinguish between the print layer and the release layer in the claim language requiring that no width-wise cuts be formed in the "printing medium." Rather, and as clearly set forth in the plain language of the claim, the first two claim elements state that the "printing medium" is comprised of at least a printing layer and a release layer, the two layers releasably adhered to one another. The last claim element then requires that no width-wise cuts be formed in the printing medium in the direction perpendicular to the conveying direction. Accordingly, even if the Examiner's interpretation of the *Jenkins* reference were correct, the reference fails to disclose each and every claim limitation by failing to disclose wherein no width-wise cuts are formed in "the printing medium." Even based on the Examiner's (erroneous) interpretation of the *Jenkins* reference, the reference still fails to anticipate the claim language as it requires width-wise cuts formed in the bottom layer 30.

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Accordingly, for at least this reason, Applicants submit that the '981 *Jenkins* disclosure fails to disclose, teach, or suggest Applicant's currently claimed invention, and that the Examiner's rejection is clearly erroneous and should be withdrawn.

Additionally, Applicants assert that the Examiner has misconstrued the '981 *Jenkins* reference. Specifically, the Examiner asserts that the bottom layer 30 of *Jenkins* is a "release layer" and that the top layer 32 is a "printing layer."

Unfortunately, such an interpretation is clearly discredited both by the '981 *Jenkins* reference and the references incorporated by reference in Col. 1, lines 36 – 50 of the '981 *Jenkins* reference.

For example, Fig. 1 and Col. 2, lines 49 – 63 of '981 *Jenkins* clearly disclose that the labels L are formed on the carrier web S. Additionally, Fig. 3 and Col. 3, lines 44 – 50 clearly disclose that the layer 30 is a label material layer, and that the layer 32 is a supporting / release layer. Col. 3, lines 55 – 60 then clearly disclose that the width-wise cuts 41 are made in the label material layer 30, not the support / release layer 32.

Furthermore, USPN 3,783,083 to the same inventor *Jenkins*, incorporated by reference in Col. 1, line 47 of the '981 reference, more clearly sets forth how one of ordinary skill in the art would have viewed the *Jenkins* '981 disclosure. Specifically, Fig.'s 19 and 20 and Col. 9, line 70 – Col. 10, line 10 clearly set forth that the label material layer 31a is the printing layer and receives the print text P, not the supporting material web 32a, and that it is the printing layer 31a that contains the width-wise cuts.

Finally, USPN 2,095,437 to *Fox*, also incorporated by reference in Col. 1, line 37 of the '981 *Jenkins* reference, also discloses that it is the printing layer 1 of the label units that receives the print g (Jones in Fig. 3) and the width-wise cuts 8, and that the backing / supporting material 4 does not receive any width-wise cuts.

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In light of the forgoing, Applicants submit that the Examiner's construction of the layers of the '981 *Jenkins* reference is clearly erroneous and is against the great weight of the evidence, including the '981 reference itself and the patents incorporated by reference in the '981 patent.

Applicants submit that it is clear that one of ordinary skill in the art of composite web structures would construe the layer 30 of *Jenkins* as the printing layer, and the layer 32 of *Jenkins* as the supporting / release layer.

Accordingly, for at least this reason also, Applicants submit that the '981 *Jenkins* disclosure fails to disclose Applicant's currently claimed invention, and that the Examiner's rejection is clearly erroneous and should be withdrawn.

Additionally, Applicants submit that the Examiner's interpretation of the cuts 38 as a "printed image" as required by paragraph 1 of claim 6 is also clearly erroneous. The *Jenkins* '981 reference discloses that the reference character 38 identifies feed cuts 38 made by the cutter 36, not a printed image. As shown in Fig. 1 and described in Col. 3, lines 7 – 12 of '981 *Jenkins*, these feed cuts made in the supporting / release layer 32 allow the spaced teeth 23 of the feed wheel 16 to engage the label rolls and pull the labels through the labeling apparatus 10. This construction is also supported by both of the *Jenkins* '083 and Fox references incorporated by reference in the *Jenkins* '981 reference.

Accordingly, for at least this reason also, Applicants submit that the '981 *Jenkins* disclosure fails to disclose Applicant's currently claimed invention, and that the Examiner's rejection is clearly erroneous and should be withdrawn.

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**B. The §103(a) Prior Art Rejection of Claims 14 – 16 Are Clearly Erroneous**

Applicants respectfully request review of the Examiner's rejection of claims 14 - 16 under 35 U.S.C. §103(a). The Examiner has rejected these claims in view of the cited references of *Jenkins* (USPN 4,457,981) and *Campbell* (USPN 4,747,782).

For at least the reasons cited above in regard to the *Jenkins* reference, Applicants submit that the 35 U.S.C. §103(a) rejection should be withdrawn as clearly erroneous, and claims 14 – 16 be placed in condition for allowance.

Additionally, Applicants submit that the Examiner's stated motivation to combine fails technically and as a matter of law. The Examiner stated in the last Office Action that "it would have been obvious to one of ordinary skill in the art to replace the full cutting means, slitters, 42, of *Jenkins* with the half-cutting means, 60, of *Campbell*, Jr. because it causes the print layer portion to be pulled off with a higher amount of force than a full cut portion..."

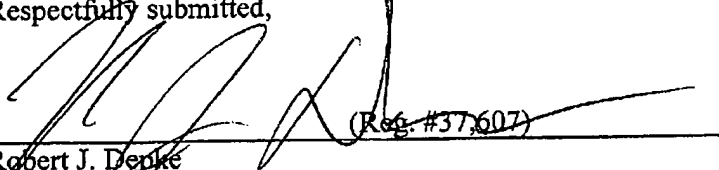
Applicants respectfully submit that the *Jenkins* '981 reference requires full cuts as it is directed to forming a plurality of separated rolls R. Incorporating the half-cut of *Campbell* in *Jenkins* '981 would render the *Jenkins* device inoperable for its intended purpose, which the courts have held is prima facie evidence of a lack of motivation to combine.

For at least this reason also, Applicants submit that the Examiner's rejection should be withdrawn as clearly erroneous, and claims 14 – 16 placed in condition for allowance.

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Date: 2/6/08

Respectfully submitted,

  
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